



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/900,551	07/06/2001	Alicia Anne Chastain	RSW920010058US1	5014
36736	7590	10/13/2006	EXAMINER LY, ANH	
DUKE W. YEE YEE & ASSOCIATES, P.C. P.O. BOX 802333 DALLAS, TX 75380			ART UNIT 2162	PAPER NUMBER

DATE MAILED: 10/13/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/900,551	<b>Applicant(s)</b> CHASTAIN ET AL.	
	<b>Examiner</b> Anh Ly	<b>Art Unit</b> 2162	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 02 August 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) 1-13, 15, 18, 20, 21 and 23-27 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 14, 16-17, 19 and 22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. This Office Action is response to Applicants' AMENDMENT and RCE filed on 08/03/2006.

#### ***Request for Continued Examination (RCE)***

2. The request filed on 04/25/2005 for a Request for Continued Examination (RCE) under 37 CFR 1.114 based on parent Application No. 09/900,551 is acceptable and a RCE has been established. An action on the RCE follows.

3. Claims 1-13, 15, 18, 20, 21 and 23-27 have been cancelled.

4. Claims 14, 16-17, 19 and 22 are pending in this application.

#### ***Claim Rejections - 35 USC § 112***

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claim 14 is rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential steps, such omission amounting to a gap between the steps. See MPEP § 2172.01. The omitted steps are: the step as set forth in the preamble "sharing text in the electronic book".

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

8. Claims 14, 16-17, 19 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Patent No.: US 6,457,026 B1 issued to Graham et al. (hereinafter Graham) in view of Patent No.: US 6,697,999 B1 issued to Breuer et al. (hereinafter Breuer).

With respect to claim 14, Graham teaches a method in a data processing system for sharing text in an electronic book (a method for transmitting/sharing electronic documents over Internet and identifying locations of the machines of the users and displaying/selecting stored electronic document containing a plurality of pages with

visual indications of the locations such as highlighting the text" figs. 2s', 3, 4 and 9's, col. 3, lines 18-67);

receiving a first user input selecting the text from the electronic book through a communications link to the data processing system (using the mouse as input device for receiving the text from electronic document or e-book to form a selected text by highlighted the selected text after the e-book is displayed (fig. 1, item 36 or 30, fig. 2's item 220 and 224, col. 3, lines 56-67 and col. 4, lines 1-8); responsive to user input and displaying the text (figs. 2s', 9s'); highlighting portions of electronic book based on the user input, wherein the highlighted portions of the electronic book correspond to the selected text received from that at least one remote electronic book (fig. 2B, col. 3, lines 57-67, col. 4, lines 45-67).

Graham teaches a method for highlighted or annotated text of stored electronic document or e-book, which contains plurality of pages including table of contents, receiving a user input via input device such as mouse or keyboard and highlighting the selected text after the e-book is displayed. Graham does not clearly teach wherein the selected text includes passages from the at least one remote electronic book, and a copy of passages from the at least one remote electronic book is also contained in the electronic book and sorting the selected text from the at least one remote electronic book using a selection criteria to form sorted text.

However, Breuer teaches e-book such as PDAs over The Internet network transmitting the portion of the selected text from one PDA machine to a remote machine

over Internet network (see fig. 2A and col. 6, lines 66-67 and col.7, lines 1-8) and displaying the sorted text in an alphabetic order (col. 8, lines 10-48).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine the teachings of Graham with the teachings of Breuer. One having ordinary skill in the art would have found it motivated to utilize the use of filtering or sorting the text and displaying the text as disclosed (Breuer's col. 7, lines 1-8 and col. 8, lines 20-28), into the system of Graham for the purpose of automatically formatting the document for each document portion, thereby, being a easiest way to give the different passages in the document to transmitting or sharing over the Internet or remotely client or machine (Breuer's col. 1, lines 5-40).

With respect to claims 16-17, Graham teaches a method in a data processing system for sharing text in an electronic book as discussed in claim 14.

Graham teaches a method for highlighted or annotated text of stored electronic document or e-book, which contains plurality of pages including table of contents, receiving a user input via input device such as mouse or keyboard and highlighting the selected text after the e-book is displayed. Graham does not clearly teach wherein selection criteria are used to sort and group the selected text, and wherein the selection criteria includes at least one of popularity, name of a user originating text within the selected text, and subject matter of portions or text within the selected text.

However, Breuer teaches displaying the sorted text in an alphabetic order (col. 8, lines 10-48).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine the teachings of Graham with the teachings of Breuer. One having ordinary skill in the art would have found it motivated to utilize the use of filtering or sorting the text and displaying the text as disclosed (Breuer's col. 7, lines 1-8 and col. 8, lines 20-28), into the system of Graham for the purpose of automatically formatting the document for each document portion, thereby, being a easiest way to give the different passages in the document to transmitting or sharing over the Internet or remotely client or machine (Breuer's col. 1, lines 5-40).

With respect to claim 19, Graham teaches wherein the selected text includes annotations made by a user (abstract, fig. 6B and col. 3, lines 17-40 and lines 48-67).

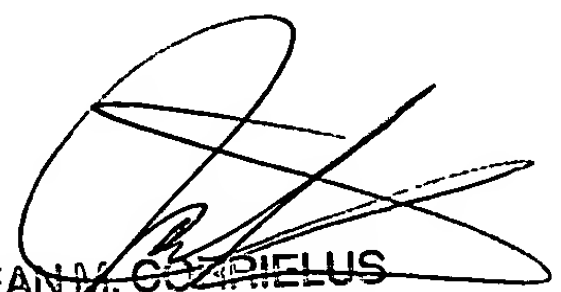
With respect to claim 22, Graham teaches wherein the sorted text excludes a portion of the selected text (figs. 2s' and 9s' and col. 8, lines 10-48).

### Contact Information

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anh Ly whose telephone number is (571) 272-4039 or via E-Mail: ANH.LY@USPTO.GOV (**Written Authorization being given by Applicant (MPEP 502.03 [R-2])) or fax to (571) 273-4039 (Examiner's personal Fax No.)**). The examiner can normally be reached on TUESDAY – THURSDAY from 8:30 AM – 3:30 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Breene, can be reached on (571) 272-4107 or **Primary Examiner: Jean Corrielus (571) 272-4032**.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). Any response to this action should be mailed to: Commissioner of Patents and Trademarks, Washington, D.C. 20231, or faxed to: **Central Fax Center: (571) 273-8300**

ANH LY   
OCT. 2<sup>nd</sup>, 2006

  
JEAN M. CORRIELUS  
PRIMARY EXAMINER